

REMARKS

In the Office Action, the Examiner rejected claims 21-29 under 35 U.S.C. § 112, indicating that the phrase "other mechanical holding devices" in claims 21 and 25 is indefinite. Claims 21 and 25 have been amended and no longer include said phrase. Therefore, it is respectfully requested that the Examiner's rejection be withdrawn.

The Examiner also rejected claims 21-29 under 35 U.S.C. § 103(a) citing several prior art references, namely, United States Patent Nos. 5,739,671 (Kang), 4,831,930 (Lcanna), 4,985,972 (Sollinger et al.), and 6,067,887 (Kapolnek), and United States Patent Application Publication No. 2003/0309112 (Huang). The claims have been amended to further distinguish the present invention from the cited references.

More specifically, independent claims 21 and 25 have been amended to specifically claim a rotary die plate which is formed of a solidified resin having a plurality of magnetic elements disposed within the resin, and that the die contactably mounts on the cylinder. Applicant respectfully submits that none of the cited references, either alone or in combination, disclose or suggest providing what is now being specifically claimed in claims 21 and 25. Therefore, Applicant respectfully asserts that claims 21 and 25, and those claims which depend therefrom, are allowable.

Claims 21 and 25 are independent. In the Office Action, the Examiner rejected these claims citing a combination of Kang, Leanna and Sollinger et al. In doing so, the Examiner pointed out that Kang does not teach that the rotary die plate is formed of a

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solidified resin having a plurality of magnetic elements therein, and "Kang and Leanna do not teach that the die plate has a plurality of magnetic elements." However, the Examiner asserted that "Sollinger teaches a rotary plate having a plurality of magnetic elements."

The Sollinger Reference is Non-Analogous Art

Applicant respectfully submits that the Sollinger reference is non-analogous art and should not be combined with either Kang or Leanna.

A prior-art reference is analogous if

- (1) the art is from the same field of endeavor, regardless of the problem addressed; and
- (2) if not from the same field of endeavor, whether it is still reasonably pertinent to the particular problem to be solved.

E.g., In re Clay, 966 F.2d 656, 658-59, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992); MPEP Section 2141.01(a). However, just because the two references at issue in this case disclose rotating cylinders, does not mean they are from the same field of endeavor. For example, in the *Clay* case, the Office argued that the prior art patent and the application at issue were part of a common endeavor: maximizing withdrawal of petroleum stored in petroleum reservoirs. The Court held that the art is not within the same field of endeavor merely because both relate to the petroleum industry. The application at issue was for storage of refined liquid hydrocarbons; the prior art patent was for the extraction of crude petroleum. In re Clay, *supra*, at 659, 23 U.S.P.Q.2d at 1060.

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Similarly, in Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 U.S.P.Q.2d 1767 (Fed. Cir. 1993), cited at Section 2141.01(a) of the MPEP, the patents-in-suit were for single in-line memory modules. The prior art at issue was for single in-line memory modules. The Federal Court stated, nonetheless:

The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories.

Id. at 864, 26 U.S.P.Q.2d at 1773 (emphasis added). Even though both the application and the prior art reference described SIMMs, they were still different fields of endeavor.

Kang, Leanna and Sollinger are similarly not in the same field of endeavor. While Kang and Leanna relate to die cutting (in Kang, see col. 1, lines 6-12; in Leanna, see col. 1, lines 8-10), Sollinger relates to a press roll for use either in paper dewatering devices or in so-called calendars (see col. 1, lines 27-29).

Additionally, Sollinger is not reasonably pertinent to the problem to be solved. An illustrative case in which prior art was found to be analogous, even though not from the same field of endeavor, is Medtronic, Inc. v. Cardiac Pacemakers, 721 F.2d 1563, 220 U.S.P.Q. 97 (Fed. Cir. 1983), cited in Section 2141.01(a) of the MPEP. The patent involved a cardiac pacemaker which included a runaway inhibitor means for preventing a pacemaker malfunction from causing pulses to be applied at too high a frequency rate.

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Two prior-art references disclosed circuits used in high power, high frequency devices which inhibited the runaway of pulses from a pulse source. The court held:

Faced with a rate-limiting problem, one of ordinary skill in the art would look to the solutions of other faced with rate-limiting problems.

Id. at 1573-74.

Kang, Leanna and Sollinger do not provide solutions to similar problems. While Kang and Leanna addressed the problem of slippage of a rotary die during a cutting operation (in Kang, see col. 2, lines 9-12; in Leanna, see col. 2, lines 32-38), Sollinger addressed the problem of providing a roll with deflection compensation (see col. 1, lines 27-34). Under the In re Clay test, the references are not analogous and should not have been combined. As such, Applicant respectfully requests that the rejection be withdrawn, among other reasons, on the basis that the Sollinger reference is non-analogous art with regard to Kang and Leanna.

Even if Sollinger is analogous, the cited combination of Kang, Leanna and Sollinger does not provide the present invention as claimed

Applicant respectfully submits that even if Sollinger can be said to be analogous, a combination of Kang, Leanna and Sollinger does not provide the present invention as claimed. None of these references disclose or suggest providing a rotary die plate formed of a solidified resin having a plurality of magnetic elements disposed within the resin. As pointed out by the Examiner, "Kang and Leanna do not teach that the die plate has a

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plurality of magnetic elements.” However, the Examiner took the position that “Sollinger teaches a rotary plate having a plurality of magnetic elements.” Sollinger discloses a roll shell 1 having multiple layers - a layer of rubber 7, a layer of metal 6, and a layer of side-by-side magnets 3. Unlike the present invention, in Sollinger, the magnets are not disposed within any type of resin. Instead, the magnets are mounted to the metal layer 6, and there is no suggestion whatsoever to have the magnets disposed in any type of resin.

Furthermore, claims 21 and 25 specifically claim rotary cutting die is contactably mountable on the metal cylinder. In contrast, in Sollinger, the magnets on the roll shell 1 are made to oppose (rather than attract) the magnets on the pole carrier 9, such that an air gap is created between the two layers of magnets (see, for example, col. 1, lines 13-15 and 47-50; col. 2, lines 53-54; col. 3, line 63; and the Abstract, lines 7-8).

The fact that the magnets oppose each other appears to be quite relevant to the invention disclosed in Sollinger as this is specifically claimed in claim 1, and the gap is specifically claimed in claims 7, 11, 20 and 22.

As such, Applicant respectfully submits that Sollinger teaches away from providing that the two magnetic layers attract each other such that there is contactable mounting, as is now specifically claimed in claims 21 and 25. A basic tenet of U.S. patent law is that “an invention that otherwise might be viewed as an obvious modification of the prior art will not be deemed obvious in a patent law sense when one or more prior art references “teach away” from the invention.” *Chisum on Patents*, §

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5.03[3], at 5-135 (2000). See, for example, Gillette Co. v. S.C. Johnson & Sons, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990) (stating that the closest prior art reference “would likely discourage the art worker from attempting the substitution suggested by the [inventor/patentee]”); American Standard Inc. v. Pfizer Inc., 14 USPQ2d 1673, 1707 (D. Del. 1989) (stating that “[a]lthough each reference used in an obviousness inquiry does not have to be enabling . . . disclosures in the references that ‘teach away’ from the claimed invention cannot be disregarded”); Phillips Petroleum Co. v. U.S. Steel Corp., 6 USPQ2d 1065, 1093 (D. Del. 1987), *aff’d*, 9 USPQ2d 1461 (Fed. Cir. 1989) (holding that “the prior art references relied upon must be considered in their entirety . . . Disclosures in the references that diverge from and teach away from the invention cannot be disregarded”); Dow Chemical Co. v. United States, 18 USPQ2d 1657, 1662 (Cl. Ct. 1990) (stating “this is a classic case of ‘teaching away’ from the invention”).

Lack of Motivation to Combine Kang, Leanna and Sollinger

A general relationship between the fields of the prior art references to be combined is insufficient to suggest the motivation. See Interactive Techs. Inc. v. Pittway Corp., Civ. App. No. 98-1464, slip op. At 13 (Fed Cir. June 1, 1999), cert. denied, 528 U.S. 1046 (1999) wherein the Court said, “The sole evidence proffered of a motivation to combine was that several prior art patents mentioned there being a similarity between garage door openers and home security systems. However, such limited evidence of there

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being a general relationship between the fields does not suggest a motivation to combine the particular references here relied upon.”

Even when changes from the prior art are “minor” or “simple”, an inquiry must be made as to whether “the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes.” Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) (quoting Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir. 1990)). Applicant respectfully submits that there is no suggestion to combine, and then modify, Kang and Leanna, as asserted by the Examiner.

Furthermore, there cannot be said to be a suggestion to combine references where the only source of the suggestion comes from the present application. As stated by the Federal Circuit in ACS Hospital Sys., Inc. v. Montefiore Hospital:

The Court below identified no source, other than the Sonnenberg patent itself, for the suggestion to use override switching means in a television rental system. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive.

732 F.2d 1572, 221 USPQ 929 (1984).

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In the present situation, the Examiner has not identified any suggestion or incentive to combine the references indicated in the Office Action, other than referring to the present invention itself.

The Leanna Reference

The Leanna reference discloses a cylinder with magnets therein, but does not disclose or suggest providing a rotary die plate with magnets disposed therein, even as an alternative embodiment. Furthermore, the Leanna patent issued some 16 years ago, yet there is no prior art of record which post-dates Leanna and discloses or suggests providing a rotary die plate with magnets therein. Applicant submits that if the present invention truly is obvious in light of Leanna, there would surely be prior art of record which post-dates Leanna and discloses or suggests the present invention. Applicant respectfully asserts that the lack of any prior art of record post-dating Leanna which discloses a rotary die plate with magnets disposed therein is further evidence that the present invention is not obvious, for example, in light of Leanna.


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Conclusion

Applicant respectfully submits that none of the cited references, either alone or in combination, disclose or suggest the present invention. Should the present claims not be deemed adequate to effectively define the patentable subject matter, the Examiner is respectfully urged to call the undersigned attorney of record to discuss the claims in an effort to reach an agreement toward allowance of the present application.

Respectfully submitted,

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